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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,385	06/19/2001	Tetsuji Ishikawa	109683	1065

25944 7590 11/14/2002

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EXAMINER

GRAY, LINDA LAMEY

ART UNIT	PAPER NUMBER
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1734

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DATE MAILED: 11/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Appli ation No.

09/883,385

Applicant(s)

ISHIKAWA ET AL.

Examiner

Linda L Gray

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-- Th MAILING DATE of this communication appears on th cov r sh et with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

and 3-14-02

- 1) ☒ Responsive to communication(s) filed on 6-19-01, 7-25-01, 10-25-01, 12-5-01, 1-2-02, 1
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7, 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *See Continuation Sheet*.

Continuation of Attachment(s) 6). Other: The Declaration filed 7-25-01 has been entered. The address changed filed 3-14-02 has been entered..

DETAILED ACTION

Drawings

1. Figures 18a-c and 19-22 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, drawn to a roll, classified in class 428, subclass 138.
- II. Claims 7-11, drawn to a roll production apparatus, classified in class 156, subclass 514.
- III. Claims 12-17, drawn to a process for producing a roll, classified in class 156, subclass 252.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case, the product as claimed can be made by another and materially different apparatus such as one having cutters.

Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as one not requiring cutting.

Inventions III and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand or (2) the apparatus as claimed can be used to practice another and materially different process (MPEP § 806.05(e)). In this case, the process as claimed can be practiced by another materially different apparatus such as one requiring cutters.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr. Kevin M. McKinley on 10-25-01 a provisional election was made with traverse to prosecute the invention of III, claims 12-17. Affirmation of this election must be made by Applicants in replying to this Office action. Claims 1-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 12 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2726856 in view of Cram et al. (US 5,620,544).**

Claims 12, JP'856 teaches a process for producing a roll (i.e., ink ribbon roller) including cutting wide main film R along its running direction while running it in the direction perpendicular to its width, thereby producing a plurality of narrow main tapes r, followed by winding each tape r to produce a roll. The process includes **(a)** sending adhesive film T from a roll including film T wound, **(b)** arranging film T on a surface of a portion of film R where the portion becomes a winding termination position of tapes r, **(c)** sticking film T on a surface of

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film R to form film t, **(d)** moving film t and film R together along their running direction, and **(e)** cutting film t together with film R.

JP'856 does not teach printing a desired item on a surface of the winding terminal position on film t.

Cram et al. teach a tab at the end of a roll of web where the tab is the winding termination position of the roll. Note that the tabs have been printed with identifying indicia (Fig 2; c 4, L 6, to c 6, L 61).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in JP'856 printing a desired item on a surface of film t because Cram et al. teach printing on a winding termination position of a roll of material in order to provide identification information about the roll where such in JP'856 would be used to provide identification information about film R which would be beneficial to those using the ink ribbon roller.

Claim 15, JP'856 teaches that film T is sent in a direction perpendicular to the running direction of film R and is then stuck on a surface of film R.

Claim 14, *JP'856 does not teach feeding film T along the running direction.*

However, such is well known alternative to perpendicular feeding, and it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in JP'856 feeding film T along the running direction because it is obvious to replace one direction of feeding with another art recognized alternative feeding direction.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2726856 in view of Cram et al. as applied to claims 12 and 14-15 above, and further in view of JP 9-226197.

Claim 13, *JP'856 does not teach forming a hole in film R where film t is over the hole.*

JP'197 teaches an ink ribbon roller with adhesive tab 17 at the end of the roll where tab 17 is the winding termination position of the roll. Note in Figure 9 the formation of holes 16 in

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ink material where tab 17 is over the hole. Note that such allows one to tape down the end of the roll after winding.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in JP'856 forming a hole in film R where film t is over the hole because JP'197 teaches providing such in the same art allows one to tape down the end of the roll after winding where such in JP'197 would prevent unnecessary unwinding of the roll.

10. Claims 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (US 4,339,294) in view of Cram et al.

Claim 12, Jones teaches a process for producing roll 13 including cutting wide main film 1 along its running direction while running it in the direction perpendicular to its width, thereby producing a plurality of narrow main tapes 11, followed by winding each tape 11 to produce roll 13. The process includes **(a)** sending an adhesive film from roll 7 including the adhesive film wound, **(b)** arranging the adhesive film on a surface of a portion of film 1 where the portion becomes a winding termination position of tapes 11, **(c)** sticking the adhesive film on a surface of film 1, **(d)** moving the adhesive film and film 1 together along their running direction, and **(e)** cutting the adhesive film together with film 1.

Jones does not teach printing a desired item on a surface of the winding terminal position on the adhesive film.

In view of Cram et al., it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Jones printing a desired item on a surface of the adhesive film because Cram et al. teach printing on a winding termination position of a roll of material in order to provide identification information about the roll where

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such in Jones would be used to provide identification information about film 1 which would be beneficial to those using the material of roll 13 for its intended purpose.

Claim 13, Jones teaches forming holes 5a and 5b in film 1 where the adhesive film is over holes 5a and 5b. **Claim 15**, Jones teaches that the adhesive film is sent in a direction perpendicular to the running direction of film 1 and is then stuck on a surface of film 1.

***Claim 14**, Jones does not teach feeding the adhesive film along the running direction.*

However, such is well known alternative to perpendicular feeding, and it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Jones feeding the adhesive film along the running direction because it is obvious to replace one direction of feeding with another art recognized alternative feeding direction.

Claim 16, Jones teaches a process for producing roll 13 including cutting a wide main film 1 along its running direction while running it in the direction perpendicular to its width, thereby producing a plurality of narrow main tapes 11, followed by winding each tape 11 to produce roll 13. The process includes sending an adhesive film from roll 7 including the adhesive film wound, arranging the adhesive film on a surface of a portion of film 1 where the portion becomes a winding initiating position of tape 1, and sticking the adhesive film to a core of roll 13.

Jones does not teach printing a desired item on a surface of the winding terminal position on the adhesive film.


In view of Cram et al., it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Jones printing a desired item on a surface of the adhesive film because Cram et al. teach printing on a winding termination position of a roll of material in order to provide identification information about the roll where such in Jones would be used to provide identification information about film 1 which would be beneficial to those using the material of roll 13 for its intended purpose.


***Claim 17**, Jones teaches forming holes 5a and 5b in film 1 where the adhesive film is over holes 5a and 5b.*

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Conclusion

11. Any inquiry concerning this or earlier communications should be directed Linda L. Gray at 703-308-1093, 6:30am-4:00pm, M-F. The examiner's supervisor, Richard Crispino, can be reached on 703-308-3853. Any general inquiries should be directed to the receptionist at 703-308-0661. The fax numbers are 703-305-7718 (before final) and 703-872-9311 (after final).

llg 
November 7, 2002


LINDA GRAY
PRIMARY EXAMINER